REMARKS

Applicant has carefully reviewed the office action mailed June 7, 2006 and offers the following remarks.

Applicant also notes with appreciation the telephonic interview that took place on June 14, 2006 between Applicant's representative Rick Witcher and Examiner Fadok. The parties discussed claim 1 in light of the Turgeon reference. In particular, Applicant requested the Examiner identify where in Turgeon certain of the elements were shown. Moreover, Applicant set forth its position that several of the elements of claim 1 are not taught by Turgeon. For his part, Examiner Fadok discussed smart card technology in general with respect to what constitutes a body or a memory. Examiner Fadok received Applicant's comments favorably, but requested that Applicant put its arguments in writing in a formal response to the Office Action. Applicant hereby does so.

Claims 1-4, 6, 9-11, 13-16, 18, 21-24, and 27 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0014371 A1 to Turgeon (hereafter "Turgeon"). Applicant respectfully traverses. For the Patent Office to prove anticipation, each and every element of the reference must be present in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131.

Before addressing the rejection, Applicant provides a brief overview of the invention. The present invention is designed to simplify a user's interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device, such as a card, that has computer readable memory associated therewith. The portable memory device has an appropriate interface through which it may communicate with the computing device during the computing session. The memory contains computer readable software that automatically executes on the computing device during the computing session. In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction. In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the present invention. To further assist the user, the software of the present invention also removes the financial information from

2

the various memories of the computing device. For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device cannot retrieve private information about the previous user.

In contrast, Turgeon is concerned about the security of sending credit card or other financial information over a public data network. Customers use a CD-ROM having an encrypted version of the critical credit card and other financial details. When the customer executes an e-commerce transaction, a purchase request, along with the encrypted card details, is sent to the merchant. The merchant provides the payment details, along with the encrypted card details, to a decryption processor that transforms the merchant's message into a decrypted, conventional payment order recognizable by the conventional banking system. Notably, the CD-ROM of Turgeon does not itself contain software that automatically executes on the customer's computer to instruct the host computer to recognize financial account fields in a web page during a browsing session, fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction, and in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

Claim 1 recites a portable device comprising: a body; a memory within the body containing software and financial account information; an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session; the software adapted to execute on the host computing device to instruct the host computing device to:

recognize financial account fields in a web page during a browsing session;

fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;

automatically execute on the host computing device in association with the computing session; and

in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

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First of all, Applicant respectfully submits that Turgeon does not teach that the software contained in the memory of the portable device is adapted to execute on the host computing device to instruct the host computing device to recognize financial account fields in a web page during a browsing session and fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction, as is required by claim 1. Turgeon does teach that the web merchant's server downloads an active Web component module to a consumer's PC over a secure transaction, and the active Web module prompts the consumer to insert the debit card and enter a PIN, and then reads the information from the card and sends the information and the PIN to the module on the web merchant's site. At this point, the active Web module on the consumer's PC closes (Turgeon, paragraphs 0030-0035). However, there is no mention of the **host computing device recognizing financial account fields** in a web page during a browsing session and **filling in the financial account fields in the web page** with the financial account information from the portable device to facilitate a web-based transaction. Turgeon simply does not disclose the recognition of financial account fields in a web page by the host computing device, nor does Turgeon disclose the form filling of the financial account fields in a web page by the host computing device. Note also that the steps that are taught in Turgeon as discussed above are initiated by the Web merchant's server, and not by the software on the portable device. For all of these reasons, Turgeon fails to teach software contained in the memory of the portable device that is adapted to execute on the host computing device to instruct the host computing device to recognize financial account fields in a web page during a browsing session and fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction. Claim 1 is thus patentable for these reasons.

In addition, Turgeon does not teach a portable device comprising a body and a memory within the body containing software and financial account information, as is required by claim 1. During the interview, Applicant requested the Examiner to identify what in Turgeon was being cited as the claimed body and memory. Applicant believes the Examiner was citing the removable, portable storage medium in Turgeon, which in Turgeon's preferred embodiment is a CD-ROM, as the claimed body and memory. The removable, portable storage medium of Turgeon – the CD – does contain encrypted and unencrypted information pertaining to the customer's financial account, but there is no mention in Turgeon that the CD contains software

adapted to execute on the host computing device to instruct the host computing device to do the steps recited in claim 1. Thus, Turgeon does not teach a portable device having a body and a memory containing software that is adapted to automatically execute on a host computing device, as is required by claim 1. Accordingly, Turgeon cannot anticipate claim 1.

Moreover, it is unclear what is considered to be the claimed host computing device in Turgeon. If the customer's computer is being equated to the claimed host computing device (see, e.g., Turgeon, paragraph 0023), then Turgeon fails to teach the invention as claimed because the CD of Turgeon does not instruct the customer's computer to carry out the steps recited in claim 1. Instead, in Turgeon, it is a microprocessor in the customer's computer which executes instructions for retrieving encrypted information from the CD and for transmitting the retrieved information to a server for a web merchant's site. The server then forwards the encrypted information along with a request for debiting a specified amount over public communication lines to a secure network for ATM or POS transactions (Turgeon, paragraph 0023). Thus, in Turgeon, it is a microprocessor in the PC that executes instructions; the CD does not instruct the host computer to do anything. Accordingly, Turgeon does not teach a memory within the body of the portable device that contains software adapted to facilitate interaction with a host computing device during a computing session, the software adapted to execute on the host computing device to instruct the host computing device to carry out certain steps, as is required in claim 1. Since Turgeon does not teach this element, it cannot anticipate claim 1.

In addition, claim 1 requires that the software **automatically** executes on the host computing device in association with the computing session. Applicant has reviewed Turegon and finds no teaching of any software that **automatically** executes on the host computing device in association with the computing session. In fact, if anything, Turgeon teaches that the customer is prompted to insert the CD and enter a PIN before any action is taken to facilitate a transaction (Turgeon, paragraphs 0023 and 0033). Thus, Turgeon fails to teach software that **automatically** executes on the host computing device in association with the computing session, as required by claim 1.

Claim 1 also recites that "in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session." Turgeon does disclose that during the Web transaction, after the information is retrieved from the CD, and

the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the **software on the portable device** that instructs the host computing device to remove records pertaining to the computing device, as required by the claimed invention. Finally, the flushing of the memory in Turgeon is not done "in association with termination of the computing session." Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (Turgeon, paragraph 0052, steps 522-570 of Figures 5b-5d). Thus, Turgeon does not teach software adapted to "in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session." Therefore, claim 1 is patentable for this additional reason.

Claim 13 is directed to a computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices, the software comprising instructions for the host computing device to carry out steps similar to those recited in claim 1. Accordingly, claim 13 contains limitations similar to those of claim 1. Claim 13 is therefore patentable for at least the same reasons set forth above with respect to claim 1.

Claim 21 is a method claim that includes the following steps: executing software resident on the portable device on a host computing device in association with a computing session; recognizing financial account fields in a web page during a browsing session; filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate the web-based transaction; and removing records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session. As set forth above with respect to claim 1, Turgeon does not teach the recognition of financial account fields in a web page by the host computing device, nor does Turgeon disclose the form filling of the financial account fields in a web page by the host computing device. Moreover, as previously mentioned, Turgeon does not teach executing software **resident on the portable device** on a host computing device in association with a computing session. In addition, as set forth above with respect to claim 1,

Turgeon does not teach removing records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session. Thus, Turegon does not teach each and every element of claim 21, and does not anticipate claim 21.

Claims 2-4, 6, and 9-11 depend from claim 1 and contain all of the limitations of claim 1. Thus, these claims are patentable over Turgeon for at least the same reasons as claim 1.

Claims 14-16 and 18 depend from claim 13 and contain all of the limitations of claim 13. Thus, these claims are patentable over Turgeon for at least the same reasons as claim 13.

Claims 22-24 and 27 depend from claim 21 and contain all of the limitations of claim 21. Thus, these claims are patentable over Turgeon for at least the same reasons as claim 21.

Claims 5, 7, 12, 17, 19, 25, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Turgeon in view of official notice. Applicant respectfully traverses. If the Patent Office must modify a reference to include a missing claim element, the Patent Office must provide a motivation to modify the reference. In addition, the Patent Office must support any such motivation with actual evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Furthermore, the modified reference must show each and every claim element to establish obviousness. MPEP § 2143.03. If the Patent Office cannot establish obviousness, then the claims are patentable. Moreover, for the Patent Office to take Official Notice, the Patent Office must have reason to believe that the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. MPEP § 2144.03A. MPEP § 2144.03C sets forth the way an Applicant may traverse Official Notice.

With respect to claims 5, 17, and 25, the Patent Office opines that placing bookmarks on a browser was old and well known in the art and that it would have been obvious to include in Turgeon placing a bookmark for easy access, because this would assure that the website is used before others as a preferred place to shop (Office Action mailed June 7, 2006, pp. 3-4). Claims 5, 17, and 25 recite that "wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser." For the Patent Office to take Official Notice, the Patent Office must have reason to believe that the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. MPEP §

2144.03A. Although bookmarks themselves may be well known, Applicant is unaware of any teaching or suggestion that was well-known at the time of invention that a bookmark for the web page **is stored on the portable device** and that software **on the portable device** is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser. In the face of Applicant's challenge, the Patent Office is obligated to provide evidence of the veracity of its claim. MPEP § 2144.03C. In the absence of such evidence, the claims are allowable.

Moreover, the Patent Office has not supported its asserted motivation to modify Turgeon with the required actual evidence. Since the Patent Office has not provided the requisite actual evidence, the proposed modification of Turgeon is improper and Turgeon must be considered alone. The Patent Office admits that Turgeon does not teach all the claim elements of claims 5, 17, and 25, and thus, these claims are patentable.

Claims 7, 19, and 27 recite that the software on the portable device is further "adapted to instruct the host computing device to query a user to select one of the plurality of shipping addresses; receive selection indicia from the user; and fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses." The Patent Office states that Turgeon teaches storing a shipping address in the portable device and an opportunity to change the stored shipping address (paragraph 0058), but admits that Turgeon does not disclose that the user is queried to select one of a plurality of shipping addresses. The Examiner takes Official Notice that offering a plurality of addresses for selection by a user was old and well known and states it would have been obvious to include a plurality of addresses because customers must be enabled to do transactions quickly or the merchant will lose customers (Office Action mailed June 7, 2006, p. 4). Initially, Applicant respectfully submits that paragraph 0058 of Turgeon does not in fact teach storing a shipping address in the portable device. Moreover, even assuming that offering a plurality of addresses was old and well known, Applicant is unaware of any teaching or suggestion that was well-known at the time of invention that **software on a portable device** can instruct a host computing device to "query a user to select one of the plurality of shipping addresses; receive selection indicia from the user; and fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses." In the face

of Applicant's challenge, the Patent Office is obligated to provide evidence of the veracity of its claim. MPEP § 2144.03C. In the absence of such evidence, the claims are allowable.

Furthermore, the Patent Office's asserted motivation to modify Turgeon does not compel the modification. Applicant does not see how a perceived need to do transactions quickly would necessitate offering a plurality of shipping addresses to a user for selection. Since the asserted motivation to modify Turegon does not compel the modification, the modification is improper and the Turgeon reference must be considered alone. The Patent Office admits that Turgeon alone does not teach or suggest all the claim elements of claims 7, 19, and 27 and thus, these claims are patentable.

With respect to claim 12, the Patent Office asserts that the use of wireless computing devices to accomplish e-commerce transactions is old and well-known in the art and that it would have been obvious to include a wireless device in Turgeon because this would increase the usage of the system in Turgeon and would increase the revenue (Office Action mailed June 7, 2006, pp. 4-5). Claim 12 recites the portable device of claim 1 wherein the interface is adapted to provide a wireless interface with the host computing device. Even if the use of wireless computing devices to accomplish e-commerce transactions may be well-known, Applicant is unaware of any teaching or suggestion that a **portable device** containing an interface that is adapted to provide a wireless interface with a host computing device such that the steps of claim 1 may be carried out was well-known at the time that the present invention was made. In the face of Applicant's challenge, the Patent Office is obligated to provide evidence of the veracity of its claim. MPEP § 2144.03C. In the absence of such evidence, the claims are allowable.

Moreover, the Patent Office has not supported its asserted motivation to modify Turgeon with the required actual evidence. Since the Patent Office has not provided the requisite actual evidence, the proposed modification of Turgeon is improper and Turgeon must be considered individually. The Patent Office admits that Turgeon alone does not teach all the claim elements of claim 12, and thus, claim 12 is patentable.

In summary, Turgeon does not teach each and every element of the claimed invention. Thus, claims 1-7, 9-19, and 21-27 are allowable. The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact
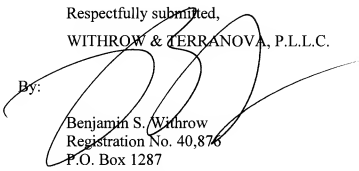
Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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